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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,568	08/02/2006	Bellamkonda Kishore	21101.0040U2	2536
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Ballard Spahr Andrews & Ingersoll, LLP SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			EXAMINER HANLEY, SUSAN MARIE	
			ART UNIT	PAPER NUMBER
			1651	
			MAIL DATE	DELIVERY MODE
			03/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,568

Applicant(s)

KISHORE ET AL.

Examiner

SUSAN HANLEY

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-102 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 4/20/06: 2/20/09

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 3-29, drawn to a composition comprising erythropoietin (Ep) and an EPIP.

Group II, claim(s) 2 and 6-29, drawn to an EPEP (erythropoietin production producing peptide).

Group III, claim(s) 30-39, drawn to cells treated with an EPEP.

Group IV, claim(s) 40, drawn to a method of administering Ep to a subject.

Group V, claim(s) 41, drawn to a method of administering an EPIP and Ep to a subject.

Group VI, claim(s) 42-67 and 71, drawn to a method of administering an EPIP to a subject.

Group VII, claim(s) 68-70, drawn to a method for testing the ability of a substance to stimulate Ep production.

Group VIII, claim(s) 72, 73 and 98-101, drawn to a method for making Ep *in vitro*.

Group IX, claim(s) 74-84, drawn to a method for method for making Ep *in vivo*.

Group X, claim(s) 85, drawn to Ep.

Group XI, claim(s) 86-91, drawn to a method of identifying signal molecules.

Group XII, claim(s) 92-97, drawn to a method of cell therapy.

Group XIII, claim(s) 98-101, drawn to a method of making a cell that makes Ep.

Group XIV, claim(s) 102, drawn to a cell that makes Ep.

The inventions listed as Groups I-XIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Specifically, as demonstrated in the International Search Report of the international stage of this application, which is part of the record of this application, WO 01/66149 (Valentis, Inc.) anticipates a number of claims, in particular at least claims 1-6, 14, 15, 30, 31, 85 and 92-98 and a number of their dependents. See, e.g., the abstract, pages 33-38 of '149 disclosing EPIPs (poly-D-glutamic acid, poly-D-aspartic acid, etc.), Ep, cells that code for Ep and having an Ep and gene therapy with the same, encompassed by the claims. Because those claims fail to make a contribution over the prior art, it is clear that all claims as filed fail to provide special technical feature common to all claimed inventions. Because the claims as filed lack a common special technical feature, the claims lack unity.

Lack of a common special technical feature, and therefore lack of unity, is further demonstrated by the fact that the various compositions, processes claimed, including binding assays, diagnostic methods and therapeutic treatment methods, all have vastly components and different process steps, and therefore also lack unity.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

The species are as follows:

- (a) values for R^1 , R^2 , R^3 , R^4 , L and X;
- (b) treatable diseases or conditions recited in claim 56-59;
- (c) monitoring methods as in claim 70;
- (d) cells for making Ep from claims 80-83;
- (e) cells for cells therapy from claims 94-97.

In addition to the election from groups I to XIV above **applicant is also required**, in reply to this action, to elect **a single species from each of (a) through (e) above**, to which the claims shall be restricted if no generic claim is finally held to be allowable. Applicant is required,

in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claims 6-29 and 43-67 correspond to specie (a);

Claims 56-59 correspond to specie (b);

Claim 70 correspond to specie (c);

Claims 80-83 correspond to specie (d); and

Claims 94-97 correspond to specie (e)

The following claim(s) are generic: 1, 2, 41, 42, 68-70, 79, and 93.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each of the possible EPIP compounds of formula I or II has different structures, chemical and physical properties requiring a different search and separate patentability determination. The same is true of the monitoring methods that require different reagents and method steps (claim 70). The cells of species (d) and (e) have different purposes and contents. Also, each of the diseases recited in claims 56-59 has a different patient set and etiology, again requiring a separate search and distinct patentability determination.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102,

103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoiner in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoiner.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN HANLEY whose telephone number is (571)272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Hanley/
Examiner, Art Unit 1651

/Irene Marx/
Primary Examiner
Art Unit 1651